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Filing date: **09/19/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91202562
Party	Plaintiff Boston Athletic Association
Correspondence Address	MICHAEL J BEVILACQUA WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109 UNITED STATES amealey@haslaw.com, tmdocket@haslaw.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	09/19/2012
Attachments	MARATHON MONDAY motion.PDF (10 pages)(364849 bytes)

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Boston Athletic Association,)	
)	
Opposer)	
)	
v.)	Opposition No. 91/202562
)	
Velocity, LLC,)	
)	
Applicant)	
)	

Opposer, Boston Athletic Association, by its counsel, hereby moves the Trademark Trial and Appeal Board, pursuant to 37 CFR §2.107 and Federal Rule of Civil Procedure 15(a), for leave to file an amended Notice of Opposition, a signed copy of which is submitted herewith as Exhibit A, that clarifies one of the allegations made in the original Notice of Opposition and clarifies the grounds for the opposition for this proceeding.

- ActiveUS 100849363v.1

Ltd. V. FMC Corp., 50 U.S.P.Q.2d 1701, 1702 (TTAB 2000). Opposer's proposed amendments are proper for the furtherance of justice, and would not violate settled law or cause harm to Applicant, Velocity, LLC, because Applicant had notice of each of the bases for the Notice of Opposition from the date it was filed and as noted below, the amendments do not add bases to the opposition, but merely clarify the facts and bases previously asserted. Additionally, Opposer submits that entry of this Amended Notice of Opposition shall not prejudice Applicant because the discovery period in this proceeding is still open.

4. In Paragraph 10 and 11 of its original Notice of Opposition, Opposer stated that the goods identified in the opposed application include "goods provided by the Opposer in association with the mark BOSTON MARATHON and its trade name ("Opposer's Goods")" and that "the goods identified in the opposed application will be marketed through the same or similar channels of trade to the same class of consumers as Opposer's Goods."

5. Since Opposer licenses other parties to provide goods under its mark BOSTON MARATHON, Opposer wishes to clarify those paragraphs. Applicant will not be prejudiced with this amendment because in every relevant response to Applicant's discovery requests in this proceeding, Opposer has been answering requests with information about these goods with the information it has from its licensees.

6. Opposer now seeks to amend its Notice of Opposition to correct original Paragraphs 10 as follows:

10. *The goods identified in Application Serial No. 85/224698 include goods provided by the Opposer and/or its licensees in association with the mark BOSTON MARATHON and its trade name ("Opposer's Goods").*

(Amendment underlined for emphasis.)

7. Also in its original Notice of Opposition, Opposer described the claimed mark as "descriptive of the Monday on which the Boston Marathon is held each year," and because the mark is descriptive of the Monday on which the Boston Marathon is held each year, Opposer alleged that "the mark creates an association with Opposer" and is therefore "not capable of

being a source identifier for the Applicant.” (See original Notice of Opposition, paragraphs 7 and 13.)

8. Opposer wishes to clarify its allegations on those points to amend the original Notice of Opposition as shown below:

Amend original Paragraph 7 to read:

7. *Since the Boston Marathon takes place on a Monday, the term “Marathon Monday” is descriptive of the Monday in April on which the Boston Marathon is held and therefore creates an [has long been associated] association with the Boston Marathon and with the Opposer.*

(Amendment underlined for emphasis.)

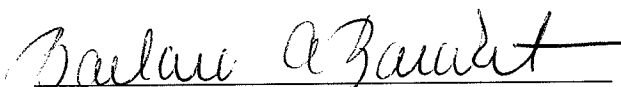
9. Opposer also notes that as the mark is descriptive, even if the Board holds that it does not create an association with Opposer, since Applicant filed its application on the basis of an intention to use the mark, Applicant has not used the mark to a degree to acquire distinctiveness to qualify for registration on the Principal Register under 15 U.S.C. §1052(f). Opposer also seeks to add the following paragraph to its Notice of Opposition:

Application Serial No. 85/224698 for registration of the mark “MARATHON MONDAY” was filed on the basis of an intent to use the mark, and on information and belief, applicant has not used the mark to a degree to acquire distinctiveness to qualify for registration under 15 U.S.C. § 1052(f).

10. Opposer could only be sure about the extent of the Applicant’s use of its mark once Applicant responded to Opposer’s discovery requests. From those responses, Opposer learned that Applicant has used its mark in commerce only from April 2011. Because Opposer has only recently confirmed that the mark has not been in use for a sufficient amount of time for the Applicant to acquire secondary meaning in it, adding this paragraph to the Notice of Opposition should be allowed and will not prejudice Applicant, who has always been aware of these facts.

11. Finally, Opposer notes that in filing its Notice of Opposition, it did not check off the boxes for the bases of its Notice of Opposition for a False Suggestion of an Association under Trademark Act Section 2(a) or descriptiveness under Trademark Act Section 2(e)(1). Opposer respectfully requests that those bases, which were claimed in its original Notice of Opposition, be maintained, despite Opposer's inadvertent failure to check those boxes in its electronic filing.

WHEREFORE, Opposer respectfully requests that it be allowed to amend its Notice of Opposition by including the clarifying statements as described above. The signed Amended Notice of Opposition is attached as Exhibit A.



Michael J. Bevilacqua

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Opposer's Motion for Leave to file Amended Notice of Opposition was served by first class mail, this 19th day of September, 2012, upon:

Andrea J. Mealey, Esq.
Hinckley, Allen & Snyder LLP
28 State Street
Boston, MA 02109



Barbara A. Barakat

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 85/224698
Published in the Official Gazette at TM 719 on July 19, 2011

Boston Athletic Association,)	
)	
Opposer)	
)	
v.)	Opposition No.
)	
Velocity, LLC,)	
)	
Applicant)	
)	

AMENDED NOTICE OF OPPOSITION

Boston Athletic Association (hereinafter “Opposer”), a non-profit corporation duly organized and existing under the laws of the Commonwealth of Massachusetts and located and doing business at 40 Trinity Place, 4th Floor, Boston, Massachusetts 02116, believes that it will be damaged by the registration of the mark “MARATHON MONDAY” as shown in Application Serial No. 85/224698 filed January 24, 2011 by Velocity, LLC (hereinafter “Applicant”), and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Applicant seeks registration on the Principal Register of the mark “MARATHON MONDAY” for use in connection with clothing, namely, tops, bottoms, headwear, sweatshirts, sweat pants, jackets, pullovers, caps, hats, socks

in international class 25.

2. Application Serial No. 85/224698 for registration of the mark “MARATHON MONDAY” was filed on January 24, 2011 based upon intent to use the mark.

3. Opposer, established in 1887, is a non-profit organization with a mission of managing athletic events and promoting a healthy lifestyle through sports, especially running.

4. Since 1897, the Opposer has organized, promoted and managed the running of the Boston Marathon each year. The race is held on the third Monday in April. The Boston Marathon, considered one of the world’s most prestigious road races, attracts professional and amateur runners from around the world.

5. Opposer is the owner of United States Trademark Registration No. 1346832, issued April 23, 1985, and United States Trademark Registration No. 1832708, issued April 26, 1994, both for the mark BOSTON MARATHON.

6. The Boston Marathon is the only major marathon run on a Monday.

7. Since the Boston Marathon takes place on a Monday, the term “Marathon Monday” is descriptive of the Monday in April on which the Boston Marathon is held and therefore creates an association with the Boston Marathon and with the Opposer.

8. Since long prior to the January 24, 2011 filing date of Applicant’s application, the phrase “Marathon Monday” has been associated with the Opposer and the Opposer’s services.

9. The attached Exhibit A shows the first few pages of results of an Internet search for the term "Marathon Monday." The majority of these results direct to the Opposer's website, or to those which discuss the Opposer or the Boston Marathon.

10. The goods identified in Application Serial No. 85/224698 include goods provided by the Opposer and/or its licensees in association with mark BOSTON MARATHON and its trade name ("Opposer's Goods").

11. On information and belief the goods identified in Application Serial No. 85/224698 will be marketed through the same or similar channels of trade to the same class of consumers as Opposer's Goods.

12. Applicant's Mark is not unique and cannot be a source identifier to Applicant due to the phrase's longstanding association with the Opposer and with the Boston Marathon.

13. Applicant's registration of the mark "MARATHON MONDAY" on the Principal Register of the United States Patent and Trademark Office will prevent Opposer from fairly describing its services.

14. Applicant's registration of the mark "MARATHON MONDAY" on the Principal Register of the United States Patent and Trademark Office will prevent Opposer from communicating with participants, fans and the general public to a significant degree.

15. Application Serial No. 85/224698 for registration of the mark "MARATHON MONDAY" was filed on the basis of an intent to use the mark,

and on information and belief, applicant has not used the mark to a degree to acquire distinctiveness to qualify for registration under 15 U.S.C. § 1052(f).

16. Based upon the foregoing, Applicant's registration of the mark "MARATHON MONDAY" on the Principal Register of the United States Patent and Trademark Office would clearly cause injury and damage to Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of the mark "MARATHON MONDAY" as shown in Application Serial Number 85/224698 be refused.

Respectfully submitted,

BOSTON ATHLETIC ASSOCIATION



Michael J. Bevilacqua

Reg. No. 31,091

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Reg. No. 32,190

Attorneys for Opposer

Wilmer Cutler Pickering Hale and Dorr LLP

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(617) 526-6000

Date: September 19, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served by first-class mail, postage-prepaid, this 19th day of September, 2012 upon:

Andrea J. Mealey, Esq.
Hinckley, Allen & Snyder LLP
28 State Street
Boston, MA 02109-1775



Barbara A. Barakat